

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

REMARKS

Reconsideration of the above identified application is respectfully requested.

On 10/16/02, the undersigned attorney conducted a phone interview with examiner Cosimano to briefly discuss the rejections of record. Agreement was reached to amend claims 29 and 35 to resolve the Section 112 rejection; and to similarly amend the independent claims to introduce means or method for dispensing an item or bank note in response to the spoken instructions from the user.

The examiner is thanked for his cooperation and assistance in further amending the claims to better distinguish over the applied references, notwithstanding the Applicants' continued traverse of the rejections under Sections 102 and 103.

In response to the Section 112 rejection of claims 29 and 35, claim 29 has been amended to depend from claim 23, and introduce the means for verifying customer identity.

Claim 35 has been amended to depend from claim 34, instead of claim 33, to introduce the customer card to verify the customer identity element recited in claim 34.

Accordingly, withdrawal of the rejection of amended claims 29 and 35 under 35 USC 112, second paragraph, is warranted and is requested.

Reference Devinney has been previously traversed in the last response by Applicants, which traverse is repeated here for the same reasons.

Nevertheless, Applicants have chosen to amend the independent claims to introduce the means or method element (18) for dispensing an item, such a bank note or ticket, to the user/customer in response to the spoken instructions or recognized speech from the user. This is disclosed in the specification at page 4, lines 4+; page 5, lines 11+; and page

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

6, lines 25+.

Although Devinney discloses many embodiments, those embodiments share the speech recognition feature to identify or verify the user. It is not seen how Devinney discloses or suggests that any of its embodiments has the capability to dispense an item to a user in response to spoken requests therefor.

Accordingly, withdrawal of the rejection of amended claims 22-24 and 30 under Section 102(b) over Devinney et al is warranted and is requested.

Applicants traverse the rejection of claims 1-21, 25-29, and 31-35 under Section 103(a) over Devinney et al, Fukatsu, and Johnstone et al for the same reasons previously presented in the last response, including the lack of an evidentiary basis to combine the three disparate references in the manner recited in the claims.

The examiner's reasons for the combinations appear to be mere conclusion, and not the legal motivation required by the MPEP.

The examiner contends that Johnstone is analogous for "solving a problem" yet that problem has not been identified by the examiner; and that problem is not the problem confronting the Applicants, as required by the applicable law on non-analogous art.

And, the CNC machine disclosed in Johnstone requires "training" for the particular machine operator to function as intended; but such operation would be impossible for an SST or ATM as recited in Applicants' claims since those devices are notoriously well known as usable by a multitude of different users, rendering the training process impractical.

At the bottom of page 3 of the office action the examiner admits that "the system of Devinney et al (WO 98/23062) does not control the operation of a transaction machine other than to verify the user [to] permit the user access to the

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

protected machine."

The examiner then attempts to combine both Fukatsu and Johnstone with Devinney by simply stating "the protected machine of Devinney et al (WO 98/23062) **could be** the ATM of either Fukatsu ('392 or '183) and that such a ATM which uses audible input device **could be** further modified to use audible instructions to control the ATM as suggested by Johnstone et al ('080)."

However, "could be" combined is not the legal motivation required by MPEP ch. 2100.

The Federal Circuit in *In re Gordon et al.*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) held that:

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

The three references Devinney, Fukatsu, and Johnstone are quite different from each other, and it is not seen how or why one skilled in the art presented with only these three references, without the use of Applicants' claims, would have combined them in any manner. Note, that the examiner's combination of these references requires two, successive layers of substitution and modification, i.e. "could be" and "further could be" which is hindsight further built upon hindsight.

Regarding claims 3 etc and the recitation of local accent or dialect, the examiner's contentions are not based on any evidence. The examiner has failed to show how any of the three applied references teach or suggest local accent. To the contrary, Johnstone requires that the CNC machine be trained to recognize the specific voice of the operator. How would a typical SST or ATM operate at all for the "any user" contention by the examiner, when it is impossible to train the

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

device to "any user?"

That a device "should be able to recognize" any user is not the same that the specifically recited device would have been obvious under Section 103.

In para. 6.1.6 of the office action, the examiner has failed to afford due weight to the express claim language. Claims 26 and 26 do not recite "directing a microphone towards the detected location," but instead recite a "directional microphone," and the additional means "for determining location of the customer."

The examiner's contention that the "input device ... should be positioned in close proximity to the detected location of the user..." is not supported by the applied references; and overlooks the obvious. Any microphone used in the applied references would inherently have the capability to receive sound; yet this is not what is recited in claims 26 and 28.

In claim 26, a directional microphone is recited. This is a special type of microphone, neither disclosed nor suggested by the three references being applied by the examiner.

In claim 28, additional means for determining location of the customer are recited, neither disclosed nor suggested by the three references being applied by the examiner.

Regarding the other claims for which the examiner has failed to provide any comments in support of the rejection, no prima facie showing has been made.

Nevertheless, in view of the examiner's cooperation in the phone interview, the independent claims have been amended to emphasize the combination of features in the SST and ATM configurations which further patentably distinguishes over the applied references as discussed above.

Accordingly, withdrawal of the rejection of claims under 1-21, 25-29, and 31-35 Section 103(a) over Devinney et al,

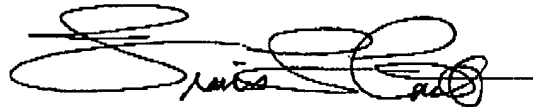
PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

Fukatsu, and Johnstone et al is warranted and is requested.

In view of the above remarks, allowance of all claims 1-35 over the art of record is warranted and is requested.

Respectfully submitted,



Date: 17 OCT 2002

Francis L. Conte
Registration No. 29,630
Attorney for Applicant

6 Puritan Avenue
Swampscott, MA 01907
Tel: 781-592-9077
Fax: 781-592-4618

Official

Appendix: pages 10-12

FAX RECEIVED

OCT 17 2002

GROUP 3600

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

Appendix

Amended claims

1. (twice amended) A self-service terminal comprising:
instructing means for producing audible terminal
operating instructions for a user;
means for dispensing an item to the user;
interface means for permitting a user to manually
interact with the terminal in response to the audible terminal
operating instructions;
means for recognizing speech, such that a user may
additionally interact with the terminal using spoken
instructions and prompts; and
means for processing user interactions with the
terminal to dispense said item in accordance with a spoken
response from the user.
6. (twice amended) A method of operating a self-service
terminal, the method comprising the steps of:
(a) producing audible terminal operating instructions
for a user;
(b) permitting a user to manually interact with the
terminal in response to the instructions produced in step (a);
(c) processing user interactions with the terminal;
[and]
(d) permitting a user to additionally input information
to the terminal using speech; and
(e) dispensing an item to the user in accordance with a
spoken response from the user.
11. (twice amended) An automated teller machine (ATM) for
allowing an ATM customer to carry out a financial transaction,
the ATM comprising:
a generating unit for providing a number of audible

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

instructions for the ATM customer; [and]

an interface for receiving inputs from the ATM customer, including a recognition unit for recognizing speech by the ATM customer to allow the ATM customer to carry out the financial transaction using spoken instructions and prompts; and

means for dispensing bank notes to the customer in accordance with a spoken response from the customer.

17. (twice amended) A method of operating an automated teller machine (ATM), the method comprising the steps of:

(a) producing audible instructions for an ATM customer to carry out a financial transaction; [and]

(b) processing inputs from the ATM customer to carry out the financial transaction, including recognizing speech by the ATM customer to allow the ATM customer to carry out the financial transaction using spoken instructions and prompts; and

(c) dispensing a bank note to the customer in accordance with a spoken response from the customer.

22. (twice amended) An automated teller machine (ATM) for allowing an ATM customer to carry out a financial transaction, the ATM comprising:

means for dispensing bank notes to the customer;

a speech processing unit for processing spoken instructions from the ATM customer and providing output signals indicative thereof; and

a processor for controlling operation of the ATM based upon the output signals from the speech processing unit, and configured to dispense the bank notes to the customer in response to the spoken instructions from the customer.

29. (amended) An ATM according to claim [28, wherein the] 23

PATENT
Docket NCR-8243

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3629

further comprising means for verifying identity of the ATM customer [includes] including a card reader for receiving a customer identifying card from the ATM customer.

30. (twice amended) A method of operating an automated teller machine (ATM), the method comprising the steps of:

(a) receiving spoken instructions from an ATM customer;
(b) processing the spoken instructions received from the ATM customer of step (a) and providing output signals indicative thereof; [and]

(c) controlling operation of the ATM based upon the output signals of step (b); and

(d) dispensing a bank note to the customer in response to the spoken instructions from the customer.

35. (amended) A method according to claim [33] 34, wherein step (d) includes the step of:

(d-1) receiving a customer identifying card from the ATM customer to verify identity of the ATM customer.